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10/709,232

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Ahmad Pourhamid

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EXAMINER

LE, KHANH H

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/709,232	<b>Applicant(s)</b> POURHAMID, AHMAD	
	<b>Examiner</b> KHANH H. LE	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

1a. This Office Action is responsive to the original application. Claims 1-14 are pending. Claims 1, 6, 8, 9 are independent.

#### ***Oath/Declaration***

1b. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It was not executed in accordance with either 37 CFR 1.66 or 1.68. The electronic signature in order to be valid has to be accompanied by forward slash marks. See MPEP 501.

#### ***Drawings***

2. The drawings are objected to because some boxes in Figures 1 and 2 are missing some edges.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3a. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**3b. Claims 1-5, 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 1 and 9:

“Using the of inside” is to be corrected.

“in combination with candy wraps” (plural) : wraps lack antecedent basis.

“the result of promotion” lacks antecedent basis, thus the scope thereof is not clear

“using of the Internet for marketing and checking” : it’s unclear who or what does the marketing, and who or what does the checking or if the same person or system does both.

Claims 2-5, and 10-14 are rejected based on their dependency on claims 1 or 9:

Claims 5, 13:

“a website to check a promotion”: it’s not clear the website has anything to do with the Url in the independent claims ; is this same promotion as in the independent claims?

(Note: since the website is not linked to the Url, the URL is still interpreted as non-functional descriptive material, again because, as claimed, the Url does not impact the methods of claims 5, 13)

Claim 8:

a method where multiple businesses use the candy wrappers of claim 6 is so broad that the claim scope is indefinite. It's unclear what the use is.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**5. Claims 6-7 are directed to non-statutory subject matter.**

These claims (wrappers with data thereon) are directed to printed matter which are not considered as being within the statutory classes. See MPEP 706.03(a), which is excerpted below:

***“706.03(a) Rejections Under 35 U.S.C. 101***

**I. SUBJECT MATTER ELIGIBILITY**

Patents are not granted for all new and useful inventions and discoveries. The subject matter of the invention or discovery must come within the boundaries set forth by 35 U.S.C. 101, which permits patents to be granted only for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."... ..

Decisions have determined the limits of the statutory classes. Examples of subject matter not patentable under the statute follow:

**A. Printed Matter**

For example, a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967). “

## **6. Claim interpretation**

### **6a. NON-FUNCTIONAL DESCRIPTIVE MATERIAL**

Claims 1 and 9: “ads” and “URL” are non-functional descriptive material and not given patentable weight to, because the method, as claimed, does not act on the ad or the url.

Claims 2-4 and 10-12: discount , prize, lottery number are non-functional descriptive material and not given patentable weight to, because the method, as claimed, does not act on the particular nature of the promotion.

Claims 6-7: web site address, advertisement and prize notification are all non-functional descriptive material to which no patentable weight is given.

(Thus any prior art having a candy wrapper with some data A (instead of web site address), on the outside and some data B and C (instead of advertisement and prize notification) on the inside would read on claims 6-7).

### **6b. Statements of intended use:**

Claims 1 and 9:  
“using said candy wraps for advertising to specific geographical area and group of customers by using a selection method of distribution to achieve targeted advertisement”, as statement of intended use, is not given patentable weight to.

Thus, Claim 9 is interpreted as equivalent to:

An advertising method comprising

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placing some data A [web site address (URL)] on the outside of candy wrap;  
placing some data B [ a promotion] inside the candy wrap;  
using the candy wrap, and using of the Internet (by a consumer) to check a result of the promotion  
wrapping candy wrappers around candy;  
mixing candy from a select group of businesses;  
and having businesses distribute the mixed candy.

Claim 1 is interpreted as equivalent to:

A advertising method comprising  
placing web site address (URL) on the outside of candy wrap;  
placing a promotion inside the candy wrap;  
using the candy wrap, and using of the Internet (by a consumer) to check a result of promotion

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Culver 2003/0088467.**

**Discussion of Culver:**

Culver discloses (abstract lines 1-12):

*“consumer promotional items, each bearing a domain name address of a website server of a promotional company are distributed to a group of sponsor companies which, in turn, distribute these items to prospective customers or users. The customers or users is the domain name indicia to access the promotional company system server and enter certain information. Responsive to this information, the website server may then be linked to the corresponding one of a group of sponsor website servers of the sponsor companies corresponding to the promotional item obtained by the user.”*

Culver also discloses a promotion code and Url printed on the inside of an item wrapper such as a candy wrapper or on “a box or ...on a separate item that is associated with the product.” [0016].

*Relevant excerpt:*

*[0016] The system of the present invention may include a promotion company, which provides a variety of types and kinds of lot-coded consumer promotional items for distribution to sponsor companies. Alternatively, the promotion company may act as sponsor when attempting to promote sales of its own coded products to potential sponsors. A domain name address of the promotion company system server and an individual lot code number are applied to each product in a manner that is not visible unless the product is opened. For example, the*



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*information may be printed on the inside of a wrapper such as a candy wrapper or a box or may be printed on a separate item that is associated with the product.*

Also see Figure 2 items 42, 44, 46 and associated text.

Culver also discloses local advertising is desired. See e.g., 2<sup>nd</sup> part of abstract, bold added:

*..In another approach, one or more media sources is used to advertise the possibility of **winning a prize** and to provide domain name address indicia for a system website of a sponsor company and code number indicia unique to each media source. Individuals access the sponsor company system server using the domain name indicia and enter certain information including geographical information of the individual. **The sponsor website server determines from the entered code number indicia, the identity of the media source connected with the code number indicia and, from the geographical information of the individual, an outlet of the sponsor company located geographically closest to the individual.** In both approaches, a website server determines if the user or individual has won a prize and, thereafter, communicates this to the individual.*

#### **Independent claim 6 and dependent claim 7:**

Claims 6-7: web site address, advertisement and prize notification are all non-functional descriptive material to which no patentable weight is given.

Thus any prior art having a candy wrapper with some data A (instead of web site address), on the outside and some data B and C (instead of advertisement and prize notification) on the inside would read on claims 6-7.

As discussed above, Culver discloses data B and C on the inside of the candy wrapper (Figure 2 items 42, 44, 46: url of promotion site and promotion code).

Culver does not explicitly disclose data A on outside of the wrapper. However usually candies are identified on the outside of their wrappers (e.g. Hershey's for Hershey's chocolates). Thus it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a "PHOSITA") to add to Culver's candies some data on the outside of the wrapper to identify them.

**Independent claim 8:**

Culver discloses a method where multiple businesses use the candy wrappers of claim 6 (abstract).

**Independent claim 1 and dependent claim 5:**

Culver discloses at abstract lines 1-12 and Figure 2 items 42, 44, 46, url of promotion site and promotion code on candy wrappers distributed by local sponsors to customers. Thus Culver discloses claims 1 and 9 except for specifically disclosing some data A [web site address (URL)] on the outside of the candy wrap.

However, since the outside data is non-functional descriptive material as discussed above, and since candy wrappers usually have some data on the outside wrapper such as to indicate candies made by Hershey's, it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a "PHOSITA") to add some data on the outside wrapper.

In the alternative interpretation, if the Url on the outside has to be given patentable weight, in discussing the Url inside the candy wrapper, Culvert also suggests printing could be done outside the candy wrapper:

*“ For example, the information may be printed on..a box or may be printed on a separate item that is associated with the product. “ [0016]*

or even explicitly on the wrapper *“Similarly, printed domain server address indicia and lot code numbers may be printed **on the wrapping**, cover or other material associated with the groups of various kinds and types of lot coded items 12 in FIG. 1 [0020]).*

Other relevant paragraphs are [0029]; [0035].

Since Culver teaches alternatives, associated with the item, to printing on the wrapper inside, and since printing on the outside of the wrapper is one such obvious alternative among a finite number of solutions (some suggested by Culver above), it would have been obvious to a PHOSITA to try such solution and to add the URL on the outside of the wrapper if desired. See also, e.g., *“Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc., Federal Register / Vol. 72, No. 195 / Wednesday, October 10, 2007 Notices, <http://www.uspto.gov/web/offices/com/sol/notices/72fr57526.pdf> (herein “ KSR Guidelines”), e.g. rationale E.*

Thus Culver modified as above discussed, discloses

A advertising method comprising  
placing some data A [web site address (URL)] on the outside of candy wrap;  
placing some data B [ a promotion] inside the candy wrap;  
using the candy wrap, and using of the Internet (by a consumer) to go to a website to check a result of the promotion (Fig 3; [0025]).

**Independent claim 9 and dependent claim 13:**

The limitations common to claims 1 and 5 are rejected as discussed above.

Further, Culver also discloses  
wrapping candy wrappers around candy (Figure 2) ;  
and having a select group of businesses ( the advertising businesses, see abstract)  
distribute the candy.

Culvert does not disclose mixing candy from by the selected businesses before distribution. However mixed candies are well-known before invention time. Thus it would have been obvious to PHOSITA to add mixing the candies to provide customers with an element of surprise.

**Claims 2-4 and 10-12:**

Culver discloses the method of claim 1 or 9, and discount , prize, lottery number are non-functional descriptive material which are not given patentable weight because the method, as claimed, does not act on the particular nature of the promotion.

Thus it would have been obvious to a PHOSITA to have the promotion be any type of data and add such to Culver as desired.

In the alternative, if prize, lottery number were to be given patentable weight, it is noted Culver also discloses the promotion is a discount (Figure 3 item 70) or a prize (Figure 3 item 62).

As to lottery numbers, since lottery number are well-known as promotions and also are the equivalent of prizes determined randomly, it would have been obvious to a PHOSITA to substitute a lottery number to the prizes taught by Culver if desired, or if market forces or design so dictate. The Supreme Court has held such simple substitution of a known element for another, or variations dictated by market or design forces, yielding predictable results (here a

lottery number would just yield a lottery prize as taught by Culver) to be obvious. See KSR guidelines cited above, Rationales B or F.

**Claim 14:**

Culver discloses the method of claim 9 but does not explicitly disclose said distribution method is giving it free to said customers. However free distribution of candies is conspicuous in retail establishments at the time of the invention, e.g. at restaurants, thus obvious to add to Culver to allow consumers to access the promotions as taught by Culver.

**Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Alden US 20050209870 A1 discloses marketing with candy wrappers (Figure 2a, 2b, ; [0017]; [0018].

DeGross, US 20020113815 A1 discloses Internet ad door on candy wrappers and the like [0059].

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday, Wednesday, and Friday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular

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communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314)..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 4, 2008

/Khanh H. Le/

Examiner, Art Unit 3688